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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:)
Bryan)
Serial No. 09/871,349) Vishu Mendiratta
Filed May 31, 2001) Examiner
For: **Game Board and Game Having a**) Group 3711
Touring Band Theme)
Attorney Docket No. 4822-001)

Raleigh, North Carolina
August 11, 2005

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

I. The court opinions cited by the Examiner in the rejections cannot, as a matter of law, serve as the source of motivations for the obviousness rejections.

As pointed out in Applicant's opening brief, the Examiner in formulating various obviousness rejections combined the primary reference of Elrod with three court opinions. Applicant argued that this was unusual, confusing and legal error.

The Examiner has addressed this issue in his Answer. In particular, the Examiner admits that "[t]he teachings provided by the cited court opinions are source of motivations in the obviousness rejection." If there was ever any doubt as to how the Examiner used the three cited opinions, the Examiner's Answer makes it clear. An obviousness rejection must be supported by a motivation to combine several references

together, or to alter a primary reference. Motivation can never come from legal precedent. Motivation must be based on factual evidence from the prior art or from the general knowledge of those skilled in the art. Here the Examiner acknowledges that he used the three cited opinions as a basis for his proffered motivation.

Every rejection lodged by the Examiner includes this flaw. Because of this alone, all of the Examiner's rejections must be reversed.

II. The Examiner has referred to the printed matter doctrine, but has failed to properly apply it.

In the Answer the Examiner argues:

Examiner takes the position that the 35 USC 103(a) rejections of claims 1-11, 13-15 over Elrod in light of the printed matter doctrine are appropriate. The only difference between applicant's game (cards, game path) and Elrod game (cards, game path) resides in meaning and information conveyed by the printed matter and would not be patentable difference. For example Elrod cards (col. 8, lines 7-34) asking the name of a band/artist can be interpreted as applicant's "band member card" or "band equipment" card. The examiner takes the position that the term "artist" on Elrod cards can be read as "band member" and the term "band" can be read as "band equipment." These differences in the printed matter are only in the meaning and information conveyed and not in the game.

The Examiner has failed to state the proper test for the application of the printed matter doctrine, and has failed to appropriately address the issue of patentability as it pertains to the printed matter doctrine. The Board, in its Remand of June 30, 2004, discussed the printed matter doctrine. The Board noted:

The "printed matter" doctrine as set forth in *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004) and *In re Gulak*, 703 F.2d 1381 (Fed. Cir. 1983) is that printed matter must be functionally related to the underlying object to be accorded patentable

weight. That is, the critical question is whether there exists and new and unobvious functional relationship between the printed matter and the substrate.

Thus, the critical question deals with the functional relationship between the printed matter that appears in the claim and the substrate that the printed matter appears on. The Examiner never addresses this question. Rather, the Examiner focuses on the differences in Applicant's printed matter and the printed matter of Elrod. That is irrelevant because such has nothing to do with the functional relationship between claimed printed matter and the underlying substrate. Indeed, in this case, the Examiner never even identified the substrate or dealt at all with the relationship of the printed matter and the substrate.

The Patent and Trademark Office has the burden of coming forth with substantial evidence proving that Applicant's claims are unpatentable. At a minimum, the Examiner must make findings as to what constitutes the substrate, what constitutes the printed matter on the substrate, and whether there is any functional relationships between the claimed printed matter and the underlying substrate. Indeed, because the Examiner has the burden of proof and implies that he is relying on the printed matter doctrine, there must be a specific finding that there is no functional relationship between the printed matter and the underlying substrate. As noted above, the issue was never analyzed and accordingly no factual findings, one way or the other, was made. The Board, in its Remand to the Examiner, spelled out the printed matter doctrine and how it applies to patentability. It is appropriate to conclude that the Examiner could not apply the printed matter doctrine and could not support a finding that there is no functional relationship between the printed matter and the underlying substrate.

Therefore, for these reasons alone, the Examiner's rejection based on the printed matter doctrine must be reversed.

III. The Examiner's argument that Elrod teaches three decks of cards is without merit.

Claim 1 calls for three separate and different decks of cards: 1) a deck of band member cards, 2) a deck of band equipment cards, and 3) a deck of consequence cards. Claim 1 particularly defines a deck of band member cards as being divided into a series of groups of cards with each group of band member cards designating members of a particular band. The band equipment cards are defined in claim 1 as a series of cards with each card designating some form of band equipment.

Elrod shows only two decks of cards, deck 124 referred to as "challenge cards," and deck 126 referred to as "rescue cards." However, the Examiner argues that the rescue deck 126 "can be divided into a large number of decks as long as each deck has a plurality of cards." Ex. Ans. p. 4. Thus, the Examiner takes the position that Elrod's rescue deck 126 can simply be divided arbitrarily and that each group can be referred to as a deck. That interpretation is not consistent with Elrod or Applicant's disclosure. In Elrod the two decks of cards 124 and 126 are clearly shown in Figure 1. There are no other decks of cards. In Applicant's disclosure the three decks of cards are shown in Figure 2 and referred to by the numerals 122, 124 and 138.

The Examiner also argues that Elrod teaches groups of band member cards. To the contrary, Elrod does not show band member cards as defined in the claims or consistent with the specification.

The Examiner fails to articulate all of the limitations pertinent to the band member cards. In claim 1 for example, paragraph (g) thereof calls for the deck of band member cards being divided into a series of groups of cards with each group designating members of a band. Thus, in each deck of band member cards there are numerous groups of cards with each group identifying a particular band. That is a part of the claimed invention, and Elrod does not teach or suggest the claimed invention or anything close to the claimed invention. The Elrod cards (col. 8, lines 7-34) are no more than trivia cards. They ask a question and if the question is answered incorrectly, the player pays money to the bank. For example, the cards discussed in col. 8, line 34 of Elrod all read very similarly with little differences other than the letters of the alphabet. In particular, the cards identified in col. 8, lines 7-34 of the Elrod patent are as follows:

Two cards-“NAME A BAND/ARTIST WHOSE FIRST WORD
BEGINS WITH EITHER ‘A’, ‘B’, OR ‘C’ PAY \$5000 TO THE
BANK

Two cards-“NAME A BAND/ARTIST WHOSE FIRST WORD
BEGINS WITH EITHER ‘D’, ‘E’, OR ‘F’ PAY \$5000 TO THE
BANK

Two cards-“NAME A BAND/ARTIST WHOSE FIRST WORD
BEGINS WITH EITHER ‘G’, ‘H’, OR ‘I’ PAY \$5000 TO THE
BANK

Two cards-“NAME A BAND/ARTIST WHOSE FIRST WORD
BEGINS WITH EITHER ‘J’, ‘K’, OR ‘L’ PAY \$5000 TO THE
BANK

Two cards-“NAME A BAND/ARTIST WHOSE FIRST WORD
BEGINS WITH EITHER ‘M’, ‘N’, OR ‘O’ PAY \$5000 TO THE
BANK

Two cards-“NAME A BAND/ARTIST WHOSE FIRST WORD
BEGINS WITH EITHER ‘P’, ‘Q’, OR ‘R’ PAY \$5000 TO THE
BANK

Two cards-“NAME A BAND/ARTIST WHOSE FIRST WORD
BEGINS WITH EITHER ‘S’, ‘T’, OR ‘U’ PAY \$5000 TO THE
BANK

Two cards-“NAME A BAND/ARTIST WHOSE FIRST WORD
BEGINS WITH EITHER ‘V’, ‘W’, ‘X’, ‘Y’ OR ‘Z’ PAY \$5000
TO THE BANK

The fifty challenge 124 cards have the following content:
One card - "SELF-CHALLENGE NAME THREE....

None of these cards can be construed or deemed band member cards or band equipment cards in the context of the claimed invention. None of the Elrod cards identify or having anything to do with band equipment.

IV. The Examiner fails to comply with the Board's Remand by not separately arguing each group of claims on appeal.

In the Board's Remand of June 30, 2004, the Board specifically remanded the case to the Examiner with instructions to respond to Appellant's argument regarding claim 14. In the original appeal, Applicant had appealed only two claims, claims 11 and 14, which were grouped separately.

After the Remand, the Examiner rejected all of the pending claims. Hence, in the latest appeal brief to the Board, Appellant has argued separately, five groups of claims. See p. 4 of Appellant's opening brief. Not only did the Examiner not address and argue claim 14, the Examiner did not respond to Appellant's arguments with respect to claim 6, claim 11, and claim 13.

V. The Examiner fails to rebut or even address the testimony of Mr. Bryan.

The prosecution history in this case includes the testimony of Mr. Paul Bryan. Decl. of Paul Bryan, Evid. App. Mr. Bryan testified to a number of factual issues including issues related to the functional relationship between printed matter and substrate carrying the printed matter. See ¶¶7 & 8 of the Bryan Decl. In the Examiner's Answer, this testimony was not even acknowledged, and certainly not rebutted. It is

urged that Mr. Bryan's testimony must be deemed true. Furthermore, since the Examiner did not even address the functional relationship between the printed matter and the substrate carrying the printed matter, the only evidence in the record and before the Board is the testimony of Mr. Bryan which establishes that there is indeed a functional relationship between the printed matter and the substrate. Since the Patent Office failed to present any evidence or even argue the issues surrounding the functional relationship between the printed matter and the substrate, then it follows that the Patent Office cannot prevail and that the rejection of all claims must be reversed.

VI. Conclusion

For the foregoing reasons, it is respectfully urged that the rejection of all of the claims should be reversed.

Although no fees should be required, if any fees are required please charge them to Deposit Account No. 18-1167.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.

By:



Larry L. Coats
Registration No. 25,620

P.O. Box 5
Raleigh, NC 27602
Telephone: (919) 854-1844

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SIGNATURE Kathy S. Stohs

DATE: 8/11/2005